

MISKIN & TSUI-YIP LLP
SERIAL NO. 09/849,635
DOCKET 551-P-002

REMARKS

THE 35 U.S.C. §112, SECOND PARAGRAPH, CLAIM REJECTION

Reconsideration is requested of the rejection of Claims 2-16, 20-35, and 37-41 under 35 U.S.C. §112, second paragraph, as “failing to set forth the subject matter which the applicant(s) regard as their invention” in light of the amendments to independent claims 38 and 39 discussed with the Examiner during the telephonic interview on April 23, 2008 and now presented in written form by this Amendment.

The rejection is directed to the issue of double inclusion, that is the multiple inclusion of one or more elements in a claim. *See*, MPEP § 2173.05(o). It is the Office’s position that “the current claims recite duplicate pairs of electrical wire-carrying conduits, and connecting members.” Without conceding the applicability of 35 U.S.C. §112, second paragraph, as an appropriate ground for rejection of Claims 2-16, 20-35, and 37-41, particularly in light of MPEP § 2173.05(o) (“There is no *per se* rule that ‘double inclusion’ is improper in a claim.”), and in the interest of advancing prosecution, Applicant has amended the independent claims, claims 38 and 39, to recite

38. (Currently Amended) A combination of a coupling member, an electrical wire-carrying conduit, and a connecting member for positioning and securing said conduit to a remote supporting structure, said combination comprising:
 ~~an said electrical wire~~ electrical wire-carrying conduit having opposite ends;
 a said coupling member receiving and supporting said conduit, said coupling member comprises a tubular member having a longitudinal axis and at least one end, said end receiving one end of said conduit along said longitudinal axis, and said tubular member having a wall containing an aperture adapted to face the remote supporting structure; and
 a said connecting member having opposite ends, one end of said connecting member securely engaging said aperture in said wall of said tubular member, the opposite end of said connecting member extending outwardly beyond said wall and adapted to securely

ROA20080225_Final20080430

MISKIN & TSUI-YIP LLP
SERIAL NO. 09/849,635
DOCKET 551-P-002

engage the remote supporting structure, to securely hold and support said coupling member and said conduit in a selected position.

39. (Currently Amended) A combination of a coupling member, a pair of electrical wire-carrying conduits, and a connecting member for positioning and securing a said pair of conduits to a remote supporting structure, said combination comprising:

a said pair of electrical wire-carrying conduit, each conduit having opposite ends;

a said coupling member receiving and supporting said conduits, said coupling member comprises an integral tubular member having a longitudinal axis and a generally cylindrical wall surrounding an interior space and opposed axially aligned ends, each of said ends receiving one end of one of said pair of conduits along said longitudinal axis, and said tubular member having an aperture through said cylindrical wall into said interior space adapted to face the remote supporting structure; and

a said connecting member having opposite ends, one end of said connecting member securely engaging said aperture in said wall of said tubular member such that said end of said connecting member extends into said interior space to securely engage said ends of said conduits being received in said coupling member, the opposite end of said connecting member extending outwardly beyond said wall and adapted to securely engage the remote supporting structure, to securely hold and support said coupling member and said pair of conduits in a selected position.

CLAIM 38

The preamble of claim 38 recites the elements "a coupling member, an electrical wire-carrying conduit, and a connecting member" preceding the transitional phrase "comprising." To emphasize that claim recitations following this transitional phrase further define these three elements ("a coupling member, an electrical wire-carrying conduit, and a connecting member"), claim 38 has been amended to recite

1. the transitional phrase refers to said combination comprising; and

2. each of

a. the coupling member is referred to as said coupling member,

ROA20080225_Final20080430

MISKIN & TSUI-YIP LLP
SERIAL NO. 09/849,635
DOCKET 551-P-002

b. the electrical wire-carrying conduit is referred to as said electrical wire-carrying conduit¹ and

c. the connecting member is referred to as said connecting member in order to ensure that it is clear that the claim recitations of coupling member, electrical wire-carrying conduit, and connecting member in the claim following the transitional "comprising" phrase refer to the coupling member, electrical wire-carrying conduit, and connecting member recited in the claim preamble before the transitional "comprising" phrase.

CLAIM 39

Similarly to claim 38, the preamble of claim 39 recites the elements "a coupling member, a pair of electrical wire-carrying conduits, and a connecting member" preceding the transitional phrase "comprising." And similarly to claim 38, claim 39 has been amended to emphasize that claim recitations following this transitional phrase further define these three elements ("a coupling member, a pair of electrical wire-carrying conduits, and a connecting member"), claim 39 has been amended to recite

1. the transitional phrase refers to said combination comprising; and

2. each of

a. the coupling member is referred to as said coupling member,

b. the pair of electrical wire-carrying conduits is referred to as said pair of electrical wire-carrying conduits and

¹ In addition to this amendment, this claim recitation has also been amended to change "electrical-wire" to -- electrical wire-carrying -- to correct a typographic error.
ROA20080225_Final20080430

MISKIN & TSUI-YIP LLP
SERIAL NO. 09/849,635
DOCKET 551-P-002

c. the connecting member is referred to as said connecting member

in order to ensure that it is clear that the claim recitations of coupling member, pair of electrical wire-carrying conduits, and connecting member in the claim following the transitional “comprising” phrase refer to the coupling member, pair of electrical wire-carrying conduits, and connecting member recited in the claim preamble before the transitional “comprising” phrase.

ADDITIONAL AMENDMENTS

CLAIM 23

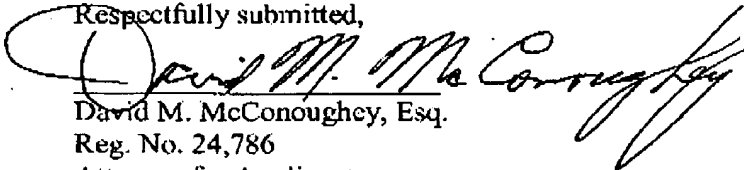
Dependent claim 23 has been amended to correct a typographic error by adding “A combination as in Claim 19 further comprising a lock nut along said end” to the beginning of the claim.

MISKIN & TSUI-YIP LLP
SERIAL NO. 09/849,635
DOCKET 551-P-002

CONCLUSION

By virtue of the Applicant's amendments to the claims and remarks thereto, it is believed that all outstanding grounds of rejection have been addressed and dealt with and, based thereon, it is believed that the application is now in condition for allowance and such action is respectfully solicited.

Respectfully submitted,


David M. McConoughey, Esq.

Reg. No. 24,786

Attorney for Applicant

Of Counsel

MISKIN & TSUI-YIP

1350 Broadway, Suite 802

New York, NY 10118

(212) 268-0900